



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,857	12/01/2003	Sharon Lesk	7288-102/10312532	2832
167 7590 07/15/2008 FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071				
EXAMINER GEHMAN, BRYON P				
ART UNIT		PAPER NUMBER		
3728				
MAIL DATE		DELIVERY MODE		
07/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,857

Applicant(s)

LESK ET AL.

Examiner

Bryon P. Gehman

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 3728

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 21 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In each claim, the phrase "an air freshener or a deodorizer" is alternative and thereby indefinite. The phrasing should be --one of an air freshener and a deodorizer--.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 4-5, 7 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto (3,477,175). Sakamoto discloses a container comprising a receptacle (11), the receptacle comprising a closed bottom, a top with an opening and a sidewall that connects the bottom and the top, and a plant stem supporting means (15) comprising a set of prongs (24). To render the receptacle "adapted to be received in a motor vehicle drink holder" would pertain to the sizing of the bottom portion (14). It has been long held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. See *In re Hutchison*, 69 USPQ 139. "When there

is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has a good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense. In that instance, the fact that a combination was obvious to try might show it was obvious under 35 U.S.C. 103. *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1731, 82 USPQ2d at 1396. It would have been an obvious matter of design choice to provide the prior art container of a particular desired size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. See *In re Rose*, 105 USPQ 237 (CCPA 1955). To modify Sakamoto by providing the means for supporting as separate from the closed bottom as claimed would entail a mere separation of parts and yield only predictable results. "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1740, 82 USPQ2d 1396 (2007). It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. See *Nerwin v. Erlichman*, 169 USPQ 177,170.

As to claim 2, prongs are clearly disclosed.

As to claims 4 and 5, a detachable ring (31) is disclosed.

As to claim 7, the container is configured to stand on its own.

As to claims 12-15, Sakamoto disclose the supporting means (15) being removably connected at the bottom of its receptacle. However, applicants claim the relatively permanent and impermanent connections as being interchangeable. To provide an element as permanent or impermanent are the two options, and to render the element either would have been obvious to one of ordinary skill to obtain the desired permanence or removability.

5. Claims 1-2, 4-9, 12-15, 18-19 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Ho (5,947,322), Borah (2,963,256) and Hinrichs (627,231) in view of Sakamoto. Ho, Borah and Hinrichs each disclose a container comprising a receptacle (1; 36; A) adapted to be received in a motor vehicle drink holder, the receptacle comprising a closed bottom, a top with an opening and a sidewall that connects the bottom and the top. Sakamoto discloses a plant stem supporting means (14) comprising a set of prongs (24) disposed in a plant stem receptacle. To modify the container of Ho employing the prongs of Sakamoto would have been obvious in order to support plant stems, as suggested by Sakamoto. The variable whether the containers of Ho and Hinrichs being adapted to being received in a motor vehicle drink holder pertains to their size, and to any degree the container of Ho or Hinrichs is not inherently sized corresponding to being received in a drink holder, to size either a container or a drink holder sufficient to have the one fit in the other would have been obvious, as plant containers of a size to be capable of being received in a conventional drink holder have been long known in the art. See *In re Rose* cited above.

As to claim 4, Ho and Hinrichs each disclose a ring (2; B1, B2).

As to claims 5-6 and 9, Ho and Hinrichs each disclose the ring as detachable and having a groove.

As to claim 7, the containers of Ho, Borah and Hinrichs are each inherently configured to stand on their own.

As to claim 8, the receptacles of Ho and Hinrichs are cup-shaped.

As to claims 12-15 and 22-23, Sakamoto disclose the supporting means (15) being removably connected at the bottom of its receptacle. However, applicants claim the relatively permanent and impermanent connections as being interchangeable. To provide an element as permanent or impermanent are the two options, and to render the element either would have been obvious to one of ordinary skill to obtain the desired permanence or removability.

As to claims 18 and 24, Hinrichs discloses a complete circumference ring.

As to claims 19 and 25, Ho discloses a partial circumference ring.

6. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Ho, Borah and Hinrichs in view of Sakamoto. The mechanical combination has been explained above. With respect to the combination of Borah, the container is actually inserted in a motor vehicle drink holder (12). With respect to the combinations of Ho and Hinrichs, to locate any article sized to fit within a motor vehicle drink holder falls within the level of common sense, and the location of any article therein would not in itself be inventive.

As to claim 11, to subsequently remove the plant container from the drink holder to display the plant container externally of the motor vehicle would have been an obvious manipulation to one of ordinary skill in the field of using plant containers.

7. Claims 1, 3 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Ho, Borah and Hinrichs in view of Stone (2,057,856). Stone discloses a plant stem supporting means comprising a frog (10) that is permanently connected to its container. To modify the plant container of any one of Ho, Borah and Hinrichs employing the frog of Stone would have been obvious in order to support plant stems therein, as suggested by Stone.

As to claims 12, 14 and 16, Stone discloses the supporting means (10) being permanently connected to the bottom of the receptacle. To provide the supporting means as a permanent connection would have been obvious to maintain the supporting means with the receptacle. However, with respect to claims 13, 15 and 17, applicants claim the relatively permanent and impermanent connections as being interchangeable. To provide an element as permanent or impermanent are the two options, and to render the element either would have been obvious to one of ordinary skill to obtain the desired permanence or removability.

8. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Ho, Borah and Hinrichs in view of Stone. The mechanical combination has been explained above. With respect to the combination of Borah, the container is

actually inserted in a motor vehicle drink holder (12). With respect to the combinations of Ho and Hinrichs, to locate any article sized to fit within a motor vehicle drink holder falls within the level of common sense, and the location of any article therein would not in itself be inventive.

As to claim 11, to subsequently remove the plant container from the drink holder to display the plant container externally of the motor vehicle would have been an obvious manipulation to one of ordinary skill in the field of using plant containers.

9. Claims 18, 21, 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as employed against claims 6 and 9 above and further in view of Holtkamp Jr. (5,477,640). Holtkamp discloses a detachable grooved ring (12 or between 14 and 22) disposed about the top of a plant and having a groove (containing 32 or containing 12) extending completely around the ring. To modify the plant container of Ho employing the ring with a groove as taught by Holtkamp Jr. would have been obvious in order to provide an air freshener capability to the plant container, as suggested by Holtkamp Jr..

10. Claims 19-20 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as employed against claims 6 and 9 above and further in view of Matthews (6,516,563). Matthews discloses a detachable grooved ring (24) disposed about the top of a plant and having a groove (30 and/or 32) that is discontinuous or extends partially around the ring. To modify the plant container of Ho employing the ring

Art Unit: 3728

with a groove as taught by Matthews would have been obvious in order to provide an adjustable container for nutrients for the plant, as suggested by Matthews.

11. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection, as explained in detail above. The 102 grounds of rejection employing prior art of an unqualified date have been removed as entirely improper. However, the differences that applicants rely on to distinguish their invention primarily fall within the long held purview of obviousness and common sense, as explained above. The examiner is of the opinion that if he had an appropriately sized flower pot, to locate the same in a motor vehicle drink holder when transporting the same would not be an inventive flash of brilliance, but rather a common sense disposition of the flower pot. Applicants' claims, other than the method claims, do not even require the drink holder, only a size to achieve such a possibility.

12. This action is made non-final in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30am to 5:00pm.

Art Unit: 3728

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Bryon P. Gehman/
Primary Examiner, Art Unit 3728

Bryon P. Gehman
Primary Examiner
Art Unit 3728

BPG